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10/628,614	07/28/2003	Roger Y. B. Young	03-0460	4439
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RYAN, MASON & LEWIS, LLP 90 FOREST AVENUE LOCUST VALLEY, NY 11560			EXAMINER LE, QUE TAN	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER Y. B. YOUNG, JOHN A. KNOCH,
and JASON W. MCNICHOLS

Appeal 2008-5124
Application 10/628,614
Technology Center 2800

Decided: February 23, 2009

Before BRADLEY R. GARRIS, CATHERINE Q. TIMM, and
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

We remand this application to the jurisdiction of the Examining Corps so that the Examiner can take necessary action consistent with our comments below.

Appellants' Appeal Brief (filed Apr. 11, 2006; "Br.") and the Amended Appeal Brief (filed Sept. 10, 2007; "Amended Br.") are defective for two reasons.

First, although independent claim 2 is expressly appealed (Br. 4) and is reproduced in the Claims Appendix (Br. 19), the pending § 103 rejection of claim 2 has not been argued (Br. 12-15) or even acknowledged (Br. 10). These circumstances suggest that Appellants have failed to argue appealed independent claim 2 by unintentional oversight. Appellants must be notified of this apparent oversight and given an opportunity to either argue the rejection of independent claim 2 or withdraw the appeal of this claim.

Second, neither the Appeal Brief nor the Amended Appeal Brief complies with 37 C.F.R. § 41.37(c)(1)(v) *Summary of claimed subject matter*. As background, Appellants were notified that the Appeal Brief is defective in failing to comply with this regulation. (*See* the "Notification of Non-Compliant Appeal Brief" mailed Aug. 8, 2007.) Appellants attempted to cure this defect by filing the Amended Appeal Brief which contains an "Amended Summary of claimed subject matter". However, this Amended Summary also fails to comply with the regulation under consideration. This is because the Amended Summary recites embodiments disclosed in the Specification without relating these embodiments to "the subject matter defined in each of the independent claims involved in the appeal" (§ 41.37 (c)(1)(v)). In addition, we observe that many of the independent and dependent method claims on appeal have been separately argued, but that the Amended Summary does not identify every step plus function in these claims and correspondingly does not identify "the structure, material, or acts

described in the specification as corresponding to each claimed function”
(*id.*).

In response to this Remand, the Examiner must notify Appellants of the Appeal Brief and Amended Appeal Brief defects discussed above and provide Appellants with an opportunity to file a new Amended Appeal Brief in order to cure these defects. (*See* the Manual of Patent Examining Procedure (MPEP) § 1205.03(Rev. 3, Aug. 2005)). If the new Amended Appeal Brief includes argument directed to the pending § 103 rejection of independent claim 2, the new Brief must completely replace the previously filed Briefs, and the Examiner must issue a Supplemental Answer responding to the claim 2 arguments. (*Id.*).

REMANDED

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